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GO DADDY GROUP, INC. 14455 NORTH HAYDEN ROAD SUITE 219 SCOTTSDALE, AZ 85260			STRODER, CARRIE A	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/811,616

Filing Date: March 29, 2004

Appellant(s): PARSONS, ROBERT R.

Stewart J. Womack
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 29 October 2010
appealing from the Office action mailed 11 May 2010.

(1) Real Party in Interest

The Examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

Related appeals and interferences: Application No. 10/811,677 has been appealed, assigned Appeal No: 2010-002850 and is pending. This application and application 10/811,677 share a common assignee, filing date, and disclosure.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 1-19 are pending and stand rejected. These claims are currently appealed.

(4) Status of Amendments After Final

The Examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The Examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The Examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office Action from which the appeal is taken (as modified by any advisory actions) is being maintained by the Examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

Examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

www.godaddy.com	Go Daddy	02-2003
20020042719	Chauchard	09-2000

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1-3, 7-9, 13-15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Go Daddy, www.godaddy.com, 02**

February 2003 (hereinafter referred to as "Go Daddy", in view of Chauchard et al. (US 20020042719 A1), based on the same reasoning provided in Examiner's previous Office Action.

Referring to claim 1:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I);

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II); and

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name.

Referring to claim 7:

Go Daddy teaches

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I);

B) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain (Section III; "Hosting"); and

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with receiving hosting services for the website associated with the domain name.

Referring to claim 13:

Go Daddy teaches:

A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I);

B) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II);

C) the Facilitator's web site offering hosting services on a hosting server for the Entrepreneur's web site at an Internet protocol address associated with a registered domain name having a label and a top-level domain (Section III; "Hosting"); and

wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (page 1).

Go Daddy does not teach; however, Chauchard teaches

C) assisting the Entrepreneur in trademarking a name (paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name and with receiving hosting services for the website associated with the domain name.

Referring to claims 2, 8, and 14:

Claims 2, 8, and 14 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches assisting the Facilitator's web site assisting the Entrepreneur in selecting an available domain name based on one or more words chosen by the Entrepreneur to describe the Entrepreneur's business (Section II).

Referring to claim 3, 9, and 15:

Claims 3, 9, and 15 are dependent on claims 1, 7, and 13; therefore, the rejections of claims 1, 7, and 13 are incorporated herein.

Go Daddy teaches the Facilitator's web site submitting an Entrepreneur's web site associated with the registered domain name to one or more search engines (Section III, as explicated by Section IV).

Referring to claim 19:

Go Daddy teaches:

- A) the Facilitator's web site allowing access to an Entrepreneur over the Internet (Section I); and
- B) the Facilitator's web site receiving information regarding the Entrepreneur that has accessed the Facilitator's web site (Section I).

C) the Facilitator's web site storing the information regarding the Entrepreneur in a memory location accessible by the Facilitator's web site (Section I);

D) the Facilitator's web site registering with a Registry a requested available domain name having a label and a top-level domain in response to the Entrepreneur's request for the domain name on the Facilitator's web site (Section II).

Go Daddy and Chauchard teach

E) the Facilitator's web site assisting the Entrepreneur in trademarking the domain name or the label with the United States Patent and Trademark Office using at least some of the stored information regarding the Entrepreneur, wherein the Facilitator's web site is accessible to a plurality of Entrepreneurs over the Internet (Go Daddy, page 1 and Chauchard, paragraphs 75-80).

Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with registering said domain name and with receiving hosting services for the website associated with the domain name.

3. **Claims 4-6, 10-12, and 16-18 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Go Daddy in view of Chauchard, as applied to claims 1-3, 7-9, 13-15, and 19, above, and further in view of the United States Patent and Trademark Office, www.uspto.gov, 29 February 2000 (hereinafter referred to as "USPTO") based on the same reasoning provided in Examiner's previous Office Action.

Referring to claims 4, 10, and 16:

Go Daddy and Chauchard fail to teach; however, USPTO teaches linking the Entrepreneur with the official web site for the United States Patent and Trademark Office (Section I).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously with applying for trademarks before the USPTO.

Referring to claims 5, 11, and 17:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating hardcopy trademark forms containing the trademark information, transmitting the hardcopy trademark forms to the Entrepreneur and instructing the Entrepreneur in the

procedure for submitting the hardcopy trademark forms to the United States Patent and Trademark Office (Section III).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously applying for trademarks before the USPTO.

Referring to claims 6, 12, and 18:

Go Daddy and Chauchard do not teach; however, USPTO teaches the steps of receiving trademark information from the Entrepreneur, creating electronic trademark forms containing the trademark information and electronically submitting the electronic trademark forms to the United States Patent and Trademark Office (Section II).

Considering Go Daddy, USPTO, and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard and USPTO for facilitating steps in registering domain names simultaneously with applying for trademarks before the USPTO.

(10) Response to Argument

I. Alleged: Not all limitations taught for claims 1, 7, 13, and 19

1. Alleged: Prior art does not teach an "Entrepreneur" that 1) trademarks a domain name or label of the domain name and 2) either registers the domain name or receives an offer for hosting services.

Applicant seems to be arguing that the word "Entrepreneur" as used in the claims is defined by other limitations in the claim. Examiner respectfully disagrees. None of the limitations of the claim define the word "entrepreneur." Further, the fact that the user is called an entrepreneur, rather than simply a "user" is a difference without a patentable distinction over the prior art. Further, Go Daddy provides a website which is built to appeal to an entrepreneur, as it provides a way to register domain names, hosting, web site design, and other services which are useful for small businesses.

2. Alleged: Prior art does not teach an Entrepreneur "trademarking the domain name or the label" [of a domain name] from a "Facilitator's web site"

Applicant also argues that the prior art does not teach an Entrepreneur trademarking the domain name or the label of a

domain name from a facilitator's web site. Examiner respectfully disagrees. Chauchard teaches assisting the entrepreneur in trademarking a name (see Abstract) via a computer connected to the internet. Chauchard does not teach using a website to offer this service. However, Go Daddy teaches using a facilitator's web site to offer services. Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with receiving hosting services for the website associated with the domain name.

3. Alleged: Prior art does not teach a "Facilitator's web site" that assists Entrepreneurs in preparing trademark applications AND either registers domain names (claims 1, 13, and 19) or offers hosting services (claim 7).

Applicant seems to be arguing that Examiner must provide prior art which provides a single web site which performs multiple claim limitations, or in other words, that Examiner cannot provide a rejection under 35 USC 103. Examiner respectfully disagrees. Examiner need not provide a single web site which performs all claimed limitations.

II. Alleged: It would not have been obvious to combine the prior Go Daddy service with Chauchard.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant implies that Examiner's OA must state where the motivation to combine is stated in the prior art. Examiner respectfully disagrees. However, Examiner will expound upon the motivation expressed. Examiner's stated motivation to combine the two pieces of prior art is, "Considering Go Daddy and Chauchard as a whole, it would have been obvious to one skilled in the art at the time of the invention to provide a process implementing a website such as Go Daddy with modifications as taught in Chauchard because this would provide a manner in which to conveniently trademark a domain name simultaneously with receiving hosting services for the website associated with the

domain name." Go Daddy provides a web site which provides hosting services, presumably for the web site associated with the domain name to be trademarked, among other services. Chauchard provides assistance in filing trademarks. It would provide an added measure of convenience for the entrepreneur to be able to find both services at one web site, as it would save the entrepreneur the time required to find the services at separate web sites. Convenience and saving time only takes into account knowledge of the person of ordinary skill in the art at the time of the invention. In these busy times, everyone is looking for a way to save time so that they may get more work done. A person having ordinary skill in the art at the time of invention would have recognized convenience as desirable.

III. Response to the OA's Response to Arguments

No response is required.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Carrie A. Stroder

/CARRIE A. STRODER/

Examiner, Art Unit 3689

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